UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,337	09/16/2003	Keiko Shiraishi	117194	9255

25944 7590 07/14/2006

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER	
PATEL, MANGLESH M	
ART UNIT	**PAPER NUMBER**
2178	

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/662,337	SHIRAISHI ET AL.	
	Examiner	Art Unit	
	Manglesh M. Patel	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This **FINAL** action is responsive to the amendment filed on April 19, 2006.

2. Claims 1-16 are pending. Claims 1, 10, 11, 12, 13 and 16 are independent claims.

Withdrawn Rejections

3. The 35 U.S.C. 103(a) rejections of claims 1-10, 16 and 16 with cited references of Rivera U.S. Pub 20040003353 in view of Thomason U.S. Pub 2003/0023625 have been withdrawn in light of the amendment.

4. The 35 U.S.C. 103(a) rejections of claims 11-12 and 14-15 with cited references of Thomason U.S. Pub 2003/0023625 in view of Rivera U.S. Pub 20040003353 have been withdrawn in light of the amendment.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-10 & 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. 6,208,427, filed Nov 18, 1997) in view of Matsushita (U.S. 6,813,036, filed Jan 28, 1999).

Regarding Independent claims 1, 10, 13 and 16, Lee discloses an instruction form retrieval apparatus comprising: a storage part that stores user information and information on an instruction form management apparatus holding an instruction form accessible to the user, associated with each other (column 1, lines 45-67 & column 2, lines 1-67, wherein the user inputs fax transmission instructions that are stored in the fax note storage section of the PDA); An input part that inputs information on a user who instructs an instruction form execution apparatus to execute one or more processing instructions indicated in the instruction form (fig 3, column 1, lines 45-67 & column 2, lines 1-67, wherein the execution apparatus executes one or more fax instructions such as header/margin information through the user interface which comprises the input part); and a retrieval part that retrieves information on the instruction form management apparatus holding the instruction form accessible to the user based on the information on the user input by the input part (fig 3, column 1, lines 45-67 & column 2, lines 1-67, wherein the retrieval part is the fax that receives the fax

instructions from the PDA, the fax note is the instruction form and describes the margin/header information). Lee fails to explicitly teach the user information associated with the fax note. Matsuhita discloses an internet facsimile machine that accepts facsimile transmission that includes user information (abstract & column 1, lines 40-67 & column 2, lines 1-67). Lee and Matsuhita are analogous art because they both teach the transmission of instructions to a facsimile device. Lee teaches an instruction form that includes header/margin instructions defined as a fax note transmitted from a PDA to a facsimile device. Matsuhita teaches the transmission of user information to a facsimile device that is associated with some predetermined information. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include user information with the instructions. The motivation for doing so would have been to improve re-transmitting operations by including user identification information of an addressee. Therefore it would have been obvious to combine the teachings of Matsuhita with Lee for the benefits of improving facsimile transmission by including user information with the facsimile note, thereby reducing errors caused by input of an addressee.

Regarding Dependent claim 2, with dependency of claim 1, Lee discloses an output part that outputs information on the instruction form management apparatus retrieved by the retrieval part to the instruction form execution apparatus used by the user (column 1, lines 45-67 & column 2, lines 1-67 & column 3, lines 25-67, wherein the bitmap image generator is the output part of the fax that reads the fax instructions to generate the output from the fax information controller which retrieves the instructions that are output to the facsimile device).

Regarding Dependent claim 3, with dependency of claim 1, an output part that outputs the information on the instruction form management apparatus retrieved by the retrieval part to a terminal used by the user (column 1, lines 45-67 & column 2, lines 1-67 & column 3, lines 25-67, wherein the data format converter converts the bit map image from the bitmap image generator into modified Huffman codes which are output to the fax).

Regarding Dependent claim 4, with dependency of claim 1, an output part that outputs a command to the instruction form management apparatus to transmit the instruction form accessible to the user to the instruction form execution apparatus used by the user, based on the information on the instruction form

management apparatus retrieved by the retrieval part (column 1, lines 45-67 & column 2, lines 1-67 & column 3, lines 25-67, wherein the bitmap image generator is the output part that outputs the instructions from the information controller which includes the instructions that are sent to the facsimile device for output).

Regarding Dependent claim 5, with dependency of claim 1, an output part that outputs a command to the instruction form management apparatus to transmit the instruction form accessible to the user to a terminal used by the user, based on the information on the instruction form management apparatus retrieved by the retrieval part (column 1, lines 45-67 & column 2, lines 1-67 & column 3, lines 25-67, wherein the instructions are sent from the PDA to a facsimile device used by the user based on the information defined in the fax note).

Regarding Dependent claim 6, with dependency of claim 2, wherein the information on the instruction form management apparatus output from the output part is information on the instruction form management apparatus holding the instruction form (column 1, lines 45-67 & column 2, lines 1-67 & column 3, lines 25-67).

Regarding Dependent claim 7, with dependency of claim 2, wherein the information on the instruction form management apparatus outputted from the output part includes information to discriminate the instruction form (column 1, lines 45-67 & column 2, lines 1-67 & column 3, lines 25-67).

Regarding Dependent claim 8, with dependency of claim 1, Lee fails to explicitly teach the user information associated with the fax note. Matsuhita discloses wherein user authentication is performed using the information on the user (abstract & column 1, lines 40-67 & column 2, lines 1-67, wherein user information includes authentication information). Lee and Matsuhita are analogous art because they both teach the transmission of instructions to a facsimile device. Lee teaches an instruction form that includes header/margin instructions defined as a fax note transmitted from a PDA to a facsimile device. Matsuhita teaches the transmission of user information to a facsimile device that is associated with some predetermined information. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include user information with the instructions. The motivation for doing so would have been

to improve re-transmitting operations by including user identification information of an addressee. Therefore it would have been obvious to combine the teachings of Matsuhita with Lee for the benefits of improving facsimile transmission by including user information with the facsimile note, thereby reducing errors caused by input of an addressee.

Regarding Dependent claim 9, with dependency of claim 1, a display information generation part that generates information to display the retrieved information on the instruction form management apparatus (column 1, lines 45-67 & column 2, lines 1-67 & column 3, lines 25-67, wherein the display information is displayed on the apparatus which is the facsimile device).

Regarding Dependent claim 14, with dependency of claim 13, outputting the retrieved information on the instruction form management apparatus to the instruction form execution apparatus used by the user (column 1, lines 45-67 & column 2, lines 1-67 & column 3, lines 25-67, wherein the instruction information is output to the fax).

Regarding Dependent claim 15, with dependency of claim 13, outputting a command to the instruction form management apparatus to transmit the instruction form accessible to the user to the instruction form execution apparatus used by the user, based on the retrieved information on the instruction form management apparatus (column 1, lines 45-67 & column 2, lines 1-67 & column 3, lines 25-67, wherein the instruction information is output to the fax based on the retrieved fax note instructions).

7. Claims 11 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadowaki (U.S. 6,674,537, filed Jun 15, 1998) in view of Lee (U.S. 6,208,427, filed Nov 18, 1997) further in view of Matsushita (U.S. 6,813,036, filed Jan 28, 1999).

Regarding Independent claims 11 and 12, Kadowaki discloses an instruction form execution apparatus comprising: An attachment part that attaches a storage medium, which is unique to a predetermined user, holding information on an instruction form management apparatus holding an instruction form accessible to the user (abstract & column 2, lines 20-45, wherein the IC card is the attachment storage medium that contains user information associated with a facsimile device); Kadowaki fails to explicitly teach instructions stored on the IC card. Lee discloses an input part that inputs the instruction form accessible to the user from

the instruction form management apparatus, based on the information on the instruction form management apparatus (column 1, lines 45-67 & column 2, lines 1-67, wherein the execution apparatus executes one or more fax instructions such as header/margin information through the user interface which comprises the input part); and an execution part that executes one or more processing instructions indicated in the input instruction form (column 1, lines 45-67 & column 2, lines 1-67, wherein the instructions described in the fax note are executed by the fax device). Lee fails to explicitly teach the user information associated with the fax note. Matsuhita discloses an internet facsimile machine that accepts facsimile transmission that includes user information (abstract & column 1, lines 40-67 & column 2, lines 1-67). Kadowaki teaches the use of an external IC card for storage of user information. Lee teaches an instruction form that includes header/margin instructions defined as a fax note transmitted from a PDA to a facsimile device. Matsuhita teaches the transmission of user information to a facsimile device that is associated with some predetermined information. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include user information with the instructions. The motivation for doing so would have been to improve re-transmitting operations by including user identification information of an addressee. Therefore it would have been obvious to combine the teachings of Matsuhita with Lee and Kadowaki for the benefits of improving facsimile transmission by including user information with the facsimile note, thereby reducing errors caused by input of an addressee.

It is noted that any citation [[s]] to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. [[See, MPEP 2123]]

Response to Arguments

8. Applicant's arguments filed April 19, 2006 have been fully considered but are moot in view of the new ground of rejection.

Conclusion

Other Prior Art Cited

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- NPL (VSI Proposes New XML Interface for Fax, xmlcoverpages, 1998, pgs 1-2)
- Beyda et al. (U.S. 6,260,160) discloses "Remote Troubleshooting Of A Computing Device"

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M, W 6 am-3 pm T, TH 6 am-2pm, Fr 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel
Patent Examiner
July 5, 2006

CESAR PAULA
PRIMARY EXAMINER